BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES

Applicant:	**Anthony E. Stuart**
Serial Number:	**09/752,700**
Atty. Docket:	**PU000189**
Filing Date:	**December 29, 2000**
For:	**ELECTRONIC PROGRAM GUIDE WITH RAPID TIME ADVANCEMENT FEATURE**
Art Unit:	**2614**
Examiner:	**Johnny Ma**
Customer No.:	24498

APPEAL BRIEF

Mail Stop Appeal Brief - Patents
Commissioner for Patents
P.O. Box 1450
Alexandria, Virginia 22313-1450

Sir:

In response to the final rejection of May 31, 2005, and further to the Notice of Appeal filed on September 2, 2005, Applicant hereby submits an Appeal Brief in accordance with 37 C.F.R. §41.37 for the above-referenced application.

I. Real Party in Interest

The real party in interest is Thomson Licensing Inc.

II. Related Appeals and Interferences

There are no prior or pending appeals, interferences, or judicial proceedings known to appellant, the appellant's legal representative, or assignee which may be related to, directly affect or be directly affected by or have a bearing on the Board's decision in this appeal.

III. Status of Claims

Claims 1-6, 8-16 and 18-21 are pending in this application, and are rejected. Claims 7 and 17 have been previously cancelled. The rejection of claims 1-6, 8-16 and 18-21 is being appealed.

IV. Status of Amendments

No amendment has been filed subsequent to final rejection.

V. Summary of Claimed Subject Matter

The claimed subject matter relates to a method and apparatus for rapidly advancing an electronic program guide (page 1, lines 1-8). The electronic program guide includes a time line 106 having notches representing discrete predefined time slots thereon delineating times and days in the future from a current day and time to which a marker 108 can be moved (page 11, line 20 to page 12, line 6, and FIGS. 4 and 5). The electronic program guide may also include a time window 77 defining a first time period on the current day, wherein the time window 77 displays indicia for programs broadcast during the first time period of the current day (FIGS. 4 and 5). The marker 108 can be moved to a notch using navigation buttons of a remote control device 32 delineating a desired day and time in the future, thereby causing to be displayed in the time window 77 a second time period displaying indicia for programs to be broadcast during the second time period on the desired day and time (page 12, lines 7-18, and FIGS. 4 and 5).

VI. Grounds of Rejection to be Reviewed on Appeal

The following grounds of rejection are presented for review in this appeal:

(1) the rejection of claims 1-5, 8-15 and 18-21 under 35 U.S.C. § 103(a) based on Finseth et al. (U.S. Publication No. 2005/0028207 A1) in view of Rector, JR et al. (U.S. Publication No. 2004/0168186); and

(2) the rejection of claims 6 and 16 under 35 U.S.C. § 103(a) based on Finseth et al. (U.S. Publication No. 2005/0028207 A1) in view of Rector, JR et al. (U.S. Publication No. 2004/0168186) and Schlarb et al. (U.S. Patent No. 6,664,984).

VII. Argument

A. Patentability of Claims 1-5, 8-15 and 18-21

Claims 1-5, 8-15 and 18-21 are allowable under U.S.C. § 103(a) over Finseth et al. (U.S. Publication No. 2005/0028207 A1) in view of Rector, JR et al. (U.S. Publication No. 2004/0168186) since one of ordinary skill in the art would have absolutely no motivation to modify Finseth et al. using the teachings of Rector, JR. et al. in the manner proposed by the Examiner. As such, the rejection of claims 1-5, 8-15 and 18-21 is clearly based on impermissible hindsight reconstruction.

It is first noted that independent claims 1, 8, 12 and 18 define:

> 1. A method for rapidly advancing an electronic program guide, comprising the steps of:
>
> producing a signal suitable for display on a display device a time line having notches representing discrete predefined time slots thereon delineating times and days in the future from a current day and time to which a marker can be moved;
>
> moving the marker using navigation buttons of a remote control device to a notch delineating a desired day and time in the future, thereby causing to be displayed in a time window displayed on the display device a time period displaying indicia for programs to be broadcast during the time period on said desired day and time.

8. A method for rapidly advancing an electronic program guide, comprising the steps of:

producing a signal suitable for display on a display device a time line having notches representing discrete predefined time slots thereon delineating times and days in the future from a current day and time to which a marker can be moved;

displaying on the display device a time window defining a first time period on the current day, wherein the time window displays indicia for programs broadcast during the first time period of the current day; and

moving the marker using navigation buttons of a remote control device to a notch delineating a desired day and time in the future, thereby causing to be displayed in the time window a second time period displaying indicia for programs to be broadcast during the second time period on said desired day and time.

12. An apparatus for rapidly advancing an electronic program guide, comprising:

a device displaying a time line having notches representing discrete predefined time slots thereon delineating times and days in the future from a current day and time; and

a marker which can be moved to a notch using navigation buttons of a remote control device delineating a desired day and time in the future, thereby causing to be displayed in a time window displayed on the device a time period displaying indicia for programs to be broadcast during the time period on said desired day and time.

18. An apparatus for rapidly advancing an electronic program guide, comprising:

a device displaying a time line having notches representing discrete predefined time slots thereon delineating times and days in the future from a current day and time to which a marker can be moved, and also displaying a time window defining a first time period on the current day, wherein the time window displays indicia for programs broadcast during the first time period of the current day; and

a marker which can be moved to a notch using navigation buttons of a remote control device delineating a desired day and time in the future, thereby causing to be displayed in the time window a second time period displaying indicia for programs to be broadcast during the second time period on said desired day and time.

As indicated above, independent claims 1, 8, 12 and 18 define a method and apparatus for rapidly advancing an electronic program guide. The electronic program guide includes a time line having notches representing discrete predefined time slots

thereon delineating times and days in the future from a current day and time to which a marker can be moved. The marker can be moved to a notch using navigation buttons of a remote control device delineating a desired day and time in the future, thereby causing to be displayed in a time window a time period displaying indicia for programs to be broadcast during the time period on the desired day and time.

In formulating the proposed combination, the Examiner relies on FIG. 4 of Finseth et al. for disclosing a timeline for rapidly advancing an electronic program guide. In particular, FIG. 4 of Finseth et al. shows an electronic program guide that provides day indicators 104 for indicating the day for which program information is presently being displayed. A jump button 100 allows users to skip to program information for a different day than that presently displayed, and a time button 102 allows users to skip to program information for a different time than that presently displayed. See paragraph 0068. Accordingly, Finseth et al. provides a method for allowing a user to advance to a desired day and time in the future in two steps. First, the user can press the jump button 100 to select a day. In doing so, one of the day indicators 104 corresponding to the selected day is highlighted. Then, the user can press time button 102 to select a different time. In the aforementioned manner, Finseth et al. provides a ***complete solution*** for allowing users to advance an electronic program guide to a desired day and time in the future, albeit a ***different solution*** than that provided by the claimed invention.

Acknowledging that the teachings of Finseth et al. fail to teach or suggest, *inter alia*, "a time line having notches representing discrete predefined time slots thereon delineating times and days in the future" as claimed, the Examiner further relies on FIG. 3 of Rector, JR. et al. for disclosing a feature of using scroll buttons 80 and 82 and a positioning button 84 for selecting various time slots in a grid. In particular, the Examiner proposes modifying "the Finseth et al. time line delineating days with the Rector, JR. et al. timeline delineating times" (see page 3 of final Office Action dated 5/31/05). However, one of ordinary skill in the art would have absolutely no motivation to modify the time line of Finseth et al. using the aforementioned teachings of Rector,

JR. et al. since Finseth et al. has already provided a ***complete solution*** for allowing users to advance an electronic program guide to a desired day and time in the future.

The fact that the Examiner attempts to modify a reference that already provides a complete solution to a problem strongly suggests that the proposed combination is the product of impermissible hindsight reconstruction. Applicant notes that "[o]ne cannot use hindsight reconstruction to pick and choose among isolated disclosures in the prior art to deprecate the claimed invention." In re Fine, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988). Moreover, "[i]t is impermissible . . . to engage in hindsight reconstruction of the claimed invention, using the applicant's structure as a template and selecting elements from references to fill the gaps." In re Gorman, 933 F.2d 982, 18 USPQ2d 1885 (Fed. Cir. 1991). In this case, the fact that the Examiner relies on Rector, JR. et al. even when Finseth et al. provides a ***complete solution*** for allowing users to advance an electronic program guide to a desired day and time in the future strongly suggests that the proposed combination is the product of impermissible hindsight reconstruction. For this reason alone, the rejection of claims 1-5, 8-15 and 18-21 should be reversed.

In the Advisory Action of 9/21/05, the Examiner attempts to defend the proposed combination by stating:

> "The combination of Finseth et al. and Rector, JR. et al. would result in the advantage that the user would not have to resort to advancing to a desired day and time in the future in two steps. Instead, the user would be able to conveniently navigate to different time periods and days via the Finseth timeline 104."

In response, Applicant points out that one of ordinary skill in the art would have absolutely no motivation to combine Finseth et al. and Rector, JR. et al. in the proposed manner. In particular, the proposed combination of Finseth et al. and Rector, JR. et al. would result in scroll buttons 80 and 82 and positioning button 84 of Rector, JR. et al. being substituted for time button 102 of Finseth et al. However, such a substitution would be extremely impractical and undesirable to one of ordinary skill in the art. In

particular, assuming the electronic program guide uses half hour intervals, there would be a total of 48 time intervals in a day. For two days, there would be a total of 96 time intervals. Accordingly, in order to provide "a time line having notches representing discrete predefined time slots thereon delineating times and days" (plural emphasized), as claimed, the time line based on the proposed combination of Finseth et al. and Rector, JR. et al. would require at least 96 discrete time intervals. Moreover, to represent a one week time period, the proposed combination would require a time line having at least 336 time intervals. Such a time line would be difficult, if not impossible, to fit on a screen. Accordingly, one of ordinary skill in the art would have absolutely no motivation to modify the time line of Finseth et al. using the teachings of Rector, JR. et al., as proposed.

In the Advisory Action of 9/21/05, the Examiner responds to this argument by stating:

> " . . . the test for obviousness is not whether the features of a secondary reference may be bodily incorporated into the structure of the primary reference; nor is it that the claimed invention must be expressly suggested in any one or all of the references. Rather, the test is what the combined teachings of the references would have suggested to those of ordinary skill in the art. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981)."

While Applicant generally agrees with the foregoing statement of law, it is noted that the combined teachings of Finseth et al. and Rector, JR. et al. in this case would clearly ***discourage*** one of ordinary skill in the art from making the proposed combination since: (i) Finseth et al. independently provides a complete solution to the problem of rapidly advancing an electronic program guide to a desired day and time in the future, and (ii) the resulting "time line" based on the proposed combination is impractical to implement.

For the foregoing reasons, Applicant submits that the rejection of claims 1-5, 8-15 and 18-21 is based on impermissible hindsight reconstruction since one of ordinary

skill in the art would have absolutely no motivation to modify Finseth et al. using the teachings of Rector, JR. et al. Accordingly, Applicant respectfully requests that the Board reverse the rejection of claims 1-5, 8-15 and 18-21.

B. Patentability of Claims 6 and 16

Claims 6 and 16 are allowable under U.S.C. § 103(a) over Finseth et al. (U.S. Publication No. 2005/0028207 A1) in view of Rector, JR et al. (U.S. Publication No. 2004/0168186) and Schlarb et al. (U.S. Patent No. 6,664,984) for at least the same reasons stated above in conjunction with claims 1-5, 8-15 and 18-21 since Schlarb et al. fails to remedy the deficiencies of the Finseth et al./Rector, JR et al. combination.

In particular, Schlarb et al. discloses a method and system for the identification of pay-per-view programming which displays a time line that can be scrolled through several days or weeks of program information. This feature is similar to the function of selecting a day using jump button 100 in Finseth et al., and therefore can not remedy the deficiencies of the Finseth et al./Rector, JR et al. combination. Accordingly, Applicant respectfully requests that the Board reverse the rejection of claims 6 and 16.

VIII. Claims Appendix

1. A method for rapidly advancing an electronic program guide, comprising the steps of:

producing a signal suitable for display on a display device a time line having notches representing discrete predefined time slots thereon delineating times and days in the future from a current day and time to which a marker can be moved;

moving the marker using navigation buttons of a remote control device to a notch delineating a desired day and time in the future, thereby causing to be displayed in a time window displayed on the display device a time period displaying indicia for programs to be broadcast during the time period on said desired day and time.

2. The method according to Claim 1, wherein the notches delineate times

that are hours, days, weeks or months in the future from the current day and time.

3. The method according to Claim 1, further comprising the step of moving the time window to view desired program indicia.

4. The method according to Claim 3, further comprising the step of moving the time window in one-half hour increments.

5. The method according to Claim 1, wherein the marker can be selectively moved forward and backward in time.

6. The method according to Claim 1, wherein the marker can be selectively moved backwards in time to display indicia for programs that were already broadcast.

8. A method for rapidly advancing an electronic program guide, comprising the steps of:

producing a signal suitable for display on a display device a time line having notches representing discrete predefined time slots thereon delineating times and days in the future from a current day and time to which a marker can be moved;

displaying on the display device a time window defining a first time period on the current day, wherein the time window displays indicia for programs broadcast during the first time period of the current day; and

moving the marker using navigation buttons of a remote control device to a notch delineating a desired day and time in the future, thereby causing to be displayed in the time window a second time period displaying indicia for programs to be broadcast during the second time period on said desired day and time.

9. The method according to Claim 8, wherein the second time period is for a period of time on a different day than the first time period

10. The method according to Claim 8, wherein the second time period

overlaps the first time period.

11. The method according to Claim 8, wherein the first and second time periods are successive time periods.

12. An apparatus for rapidly advancing an electronic program guide, comprising:

a device displaying a time line having notches representing discrete predefined time slots thereon delineating times and days in the future from a current day and time; and

a marker which can be moved to a notch using navigation buttons of a remote control device delineating a desired day and time in the future, thereby causing to be displayed in a time window displayed on the device a time period displaying indicia for programs to be broadcast during the time period on said desired day and time.

13. The apparatus according to Claim 12, wherein the notches delineate times that are hours, days, weeks and months in the future from the current day and time.

14. The apparatus according to Claim 12, wherein the time window can be moved in one-half hour increments.

15. The apparatus according to Claim 12, wherein the marker can be selectively moved forward and backward in time.

16. The apparatus according to Claim 12, wherein the marker can be selectively moved backwards in time to display indicia for programs that were already broadcast.

18. An apparatus for rapidly advancing an electronic program guide, comprising:

a device displaying a time line having notches representing discrete predefined

time slots thereon delineating times and days in the future from a current day and time to which a marker can be moved, and also displaying a time window defining a first time period on the current day, wherein the time window displays indicia for programs broadcast during the first time period of the current day; and

a marker which can be moved to a notch using navigation buttons of a remote control device delineating a desired day and time in the future, thereby causing to be displayed in the time window a second time period displaying indicia for programs to be broadcast during the second time period on said desired day and time.

19. The apparatus according to Claim 18, wherein the second time period is for a period of time on a different day than the first time period

20. The apparatus according to Claim 18, wherein the second time period overlaps the first time period.

21. The apparatus according to Claim 18, wherein the first and second time periods are successive time periods.

IX. Evidence Appendix

None.

X. Related Proceedings Appendix

None.

Please charge the fee for this Appeal Brief to Deposit Account 07-0832.

Respectfully submitted,

By: Reitseng Lin
Reg. No. 42,804
Phone (609) 734-6813

Patent Operations
Thomson Licensing Inc.
P.O. Box 5312
Princeton, New Jersey 08540
October 27, 2005

CERTIFICATE OF MAILING

I hereby certify that this amendment is being deposited with the United States Postal Service as First Class Mail, postage prepaid, in an envelope addressed to [Mail Stop ~~Amendment~~ Appeal], Commissioner for Patents, Alexandria, Virginia 22313-1450 on:

10/27/05
Date

Linda Tindall
Linda Tindall

Customer Number 24498

Privacy Act Statement

The **Privacy Act of 1974 (P.L. 93-579)** requires that you be given certain information in connection with your submission of the attached form related to a patent application or patent. Accordingly, pursuant to the requirements of the Act, please be advised that: (1) the general authority for the collection of this information is 35 U.S.C. 2(b)(2); (2) furnishing of the information solicited is voluntary; and (3) the principal purpose for which the information is used by the U.S. Patent and Trademark Office is to process and/or examine your submission related to a patent application or patent. If you do not furnish the requested information, the U.S. Patent and Trademark Office may not be able to process and/or examine your submission, which may result in termination of proceedings or abandonment of the application or expiration of the patent.

The information provided by you in this form will be subject to the following routine uses:
1. The information on this form will be treated confidentially to the extent allowed under the Freedom of Information Act (5 U.S.C. 552) and the Privacy Act (5 U.S.C 552a). Records from this system of records may be disclosed to the Department of Justice to determine whether disclosure of these records is required by the Freedom of Information Act.
2. A record from this system of records may be disclosed, as a routine use, in the course of presenting evidence to a court, magistrate, or administrative tribunal, including disclosures to opposing counsel in the course of settlement negotiations.
3. A record in this system of records may be disclosed, as a routine use, to a Member of Congress submitting a request involving an individual, to whom the record pertains, when the individual has requested assistance from the Member with respect to the subject matter of the record.
4. A record in this system of records may be disclosed, as a routine use, to a contractor of the Agency having need for the information in order to perform a contract. Recipients of information shall be required to comply with the requirements of the Privacy Act of 1974, as amended, pursuant to 5 U.S.C. 552a(m).
5. A record related to an International Application filed under the Patent Cooperation Treaty in this system of records may be disclosed, as a routine use, to the International Bureau of the World Intellectual Property Organization, pursuant to the Patent Cooperation Treaty.
6. A record in this system of records may be disclosed, as a routine use, to another federal agency for purposes of National Security review (35 U.S.C. 181) and for review pursuant to the Atomic Energy Act (42 U.S.C. 218(c)).
7. A record from this system of records may be disclosed, as a routine use, to the Administrator, General Services, or his/her designee, during an inspection of records conducted by GSA as part of that agency's responsibility to recommend improvements in records management practices and programs, under authority of 44 U.S.C. 2904 and 2906. Such disclosure shall be made in accordance with the GSA regulations governing inspection of records for this purpose, and any other relevant (*i.e.*, GSA or Commerce) directive. Such disclosure shall not be used to make determinations about individuals.
8. A record from this system of records may be disclosed, as a routine use, to the public after either publication of the application pursuant to 35 U.S.C. 122(b) or issuance of a patent pursuant to 35 U.S.C. 151. Further, a record may be disclosed, subject to the limitations of 37 CFR 1.14, as a routine use, to the public if the record was filed in an application which became abandoned or in which the proceedings were terminated and which application is referenced by either a published application, an application open to public inspection or an issued patent.
9. A record from this system of records may be disclosed, as a routine use, to a Federal, State, or local law enforcement agency, if the USPTO becomes aware of a violation or potential violation of law or regulation.

PTO/SB/17 (12-04v2)
Approved for use through 07/31/2006. OMB 0651-0032
U.S. Patent and Trademark Office; U.S. DEPARTMENT OF COMMERCE
Under the Paperwork Reduction Act of 1995 no persons are required to respond to a collection of information unless it displays a valid OMB control number

AFS DFW

Effective on 12/08/2004.

Fees pursuant to the Consolidated Appropriations Act, 2005 (H.R. 4818).

FEE TRANSMITTAL for FY 2005

OIPE 2458 OCT 31 2005 PATENT & TRADEMARK OFFICE

☐ Applicant claims small entity status. See 37 CFR 1.27

TOTAL AMOUNT OF PAYMENT ($) 500.00

Complete if Known	
Application Number	09/752,700
Filing Date	December 29, 2000
First Named Inventor	Anthony E. Stuart
Examiner Name	Johnny Ma
Art Unit	2614
Attorney Docket No.	PU000189

METHOD OF PAYMENT *(check all that apply)*

☐ Check ☐ Credit card ☐ Money Order ☐ None ☐ Other (please identify): _____

Customer Number 24498

☒ Deposit Account: Deposit Account Number 07-0832 Deposit Account Name: THOMSON LICENSING INC.

For the above-identified deposit account, the Director is hereby authorized to: (check all that apply)

☒ Charge fee(s) indicated below ☐ Charge fee(s) indicated below, **except for the filing fee**

☒ Charge any additional fee(s) or underpayments of fee(s) under 37 CFR 1.16 and 1.17 ☒ Credit any overpayments

WARNING: Information on this form may become public. Credit card information should not be included on this form. Provide credit card information and authorization on PTO-2038.

FEE CALCULATION

1. BASIC FILING, SEARCH, AND EXAMINATION FEES

	FILING FEES	Small Entity	SEARCH FEES	Small Entity	EXAMINATION FEES	Small Entity	
Application Type	**Fee ($)**	**Fee ($)**	**Fee ($)**	**Fee ($)**	**Fee ($)**	**Fee ($)**	**Fees Paid ($)**
Utility	300	150	500	250	200	100	
Design	200	100	100	50	130	65	
Plant	200	100	300	150	160	80	
Reissue	300	150	500	250	600	300	
Provisional	200	100	0	0	0	0	

2. EXCESS CLAIM FEES

Fee Description	Small Entity Fee ($)	Small Entity Fee ($)
Each claim over 20 (including Reissues)	50	25
Each independent claim over 3 (including Reissues)	200	100
Multiple dependent claims	360	180

Total Claims		**Extra Claims**	**Fee ($)**	**Fee Paid ($)**
_____	- 20 or HP =	_____	x _____	= _____

HP = highest number of total claims paid for, if greater than 20.

Independent Claims		**Extra Claims**	**Fee ($)**	**Fee Paid ($)**
_____	- 3 or HP =	_____	x _____	= _____

HP = highest number of independent claims paid for, if greater than 3.

Multiple Dependent Claims

Fee ($)	**Fee Paid ($)**
_____	_____

3. APPLICATION SIZE FEE

If the specification and drawings exceed 100 sheets of paper (excluding electronically filed sequence or computer listings under 37 CFR 1.52(e)), the application size fee due is $250 ($125 for small entity) for each additional 50 sheets or fraction thereof. See 35 U.S.C. 41(a)(1)(G) and 37 CFR 1.16(s).

Total Sheets		**Extra Sheets**		**Number of each additional 50 or fraction thereof**	**Fee ($)**	**Fee Paid ($)**
_____	- 100 =	_____	/ 50 =	_____ (round **up** to a whole number) x	_____	= _____

4. OTHER FEE(S)

	Fees Paid ($)
Non-English Specification, $130 fee (no small entity discount)	
Other (e.g., late filing surcharge): Appeal Brief	$500.00

SUBMITTED BY

Name (Print/Type)	Reitseng Lin	*Registration No. (Attorney/Agent)*	42,804	*Telephone*	(609) 734-6813
Signature					